



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,232	02/22/2005	Werner Gauweiler	266122US0PCT	7199
22850	7590	07/03/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
ROGERS, JAMES WILLIAM				
ART UNIT		PAPER NUMBER		
1618				
NOTIFICATION DATE		DELIVERY MODE		
07/03/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/525,232

Applicant(s)

GAUWEILER ET AL.

Examiner

JAMES W. ROGERS

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-15 is/are pending in the application.
4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3, 6 and 8-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SI-108)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

The amendments to the claims filed 05/22/2008 have been entered. Any rejection/objection from the previous office action not addressed within the action below has been withdrawn.

Claim Objections

Claim 1 is objected to for the reasons set forth in the previous office action filed 01/22/2008. Since applicants did not address this objection it still stands.

Response to Arguments

Claims 1-2,8-9 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Maurin et al. (US 6,403,542), for the reasons set forth in the previous office action filed 01/22/2008. A new rejection of claim 15 was necessitated by applicants amendments to the claims.

Regarding claim 15 Maurin clearly teaches the use of several inorganic salts such as anionic surfactants including alkaline salts and magnesium salts as well as basifying substances such as NaOH. See col 4 lin 12-14, claims and example.

Applicant's arguments filed 05/22/2008 have been fully considered but they are not persuasive.

Applicants assert that the polymers of Maurin are prepared by conventional methods and uses commercially available polymers wherein applicants claimed invention the composition comprises cationic polymers produced by a free-radical water-in-water emulsion polymerization. Applicants contend that their examples 1 and 3 made from water-in-water (W/W) emulsions of monomer mixtures demonstrate

improved effects on hair with regards to the combing force when compared to examples 4 and 5 that are produced from solution polymerization of the monomers.

The relevance of these assertions is unclear. Applicants claims as currently amended are drawn to a method of cosmetically treating hair, skin or nails by applying an aqueous polymer dispersion, the claims **are not** drawn to a method of producing an aqueous polymers dispersion. Essentially the limitation within claim 1 that states the cationic polymer is prepared by free radical water-in-water is a product by process type of limitation for the composition; however the composition is not even claimed. Since Maurin teaches applying compositions with the same ingredients claimed by applicants for the treatment hair all of the limitations of the rejected claims above are met. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Even though applicants state that the cationic polymers of Maurin are produced from a different method the claims must recite a limitation on treating hair that is not recited or inherent from the teachings of Maurin. Regarding applicant's assertion that examples 1 and 3 produced from water-in-water emulsions have improved effects than examples 4 and 5 produced by solution, independent claim 1 does not recite a feature or property for the method of treating the hair that would preclude the hair compositions of Maurin.

Art Unit: 1618

Furthermore it appears as though applicants are arguing unexpected results for their claimed composition, however evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

Claims 1-3,6 and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schade et al. (US 5,962,613) in view of Maurin et al. (US 6,403,542), for the reasons set forth in the previous office action filed 01/22/2008.

A new rejection of claim 15 was necessitated by applicant's amendments to the claims.

Applicant's arguments filed 05/22/2008 have been fully considered but they are not persuasive.

Applicants assert as in the above remarks on Maurin that the polymers of Maurin and Schade are prepared by conventional methods whereas within applicants claimed invention the composition comprises cationic polymers produced by a free-radical water-in-water emulsion polymerization. Applicants contend that examples 1-5 from the specification demonstrate that the polymer formed by a water-in-water emulsion polymerization is different than a polymer produced by solution polymerization. Applicants lastly state that since the polymer materials disclosed by the two patent are different than the copolymer of the present invention by a different polymerization process one of ordinary skill in the art would not have a reasonable expectation of

success in adding a cationic vinyl lactam within one reference and substituting it for the other polymer.

The relevance of these assertions is unclear. Applicants claims as currently amended are drawn to a method of cosmetically treating hair, skin or nails by applying an aqueous polymer dispersion, the claims **are not** drawn to a method of producing an aqueous polymers dispersion. Essentially the limitation within claim 1 that states the cationic polymer is prepared by free radical water-in-water emulsion polymerization is a product by process type of limitation for a composition; however a composition is not claimed. Since the combination of Schade and Maurin disclose applying compositions within the same scope of applicants claimed invention to treat hair all of the limitations of the rejected claims above are met. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In order for applicants claims not to read on the combination above applicants must recite a limitation on treating hair that is not obvious from the disclosures of Schade and Maurin. The relevance of applicant's assertion that examples 1 and 3 produced from water-in-water emulsions have improved structure, high solid content and shampoo properties than examples 4 and 5 produced by solution polymerization is unclear. Firstly applicant's claim 1 does not claim a shampoo which

Art Unit: 1618

softens hair so that a particular applied force can comb it is not claimed; therefore this argument does not appear to be relevant to the claimed invention. As described above independent claim 1 does not recite a feature or property for the method of treating the hair that would preclude the combination of Schade and Maurin. Since the method of treating hair by applying the composition disclosed by the combination of Schade and Maurin falls within the scope of applicants claimed invention all limitations within the currently amended claims are considered met. Furthermore it is noted by the examiner that examples 1-5 are very narrow as to the contents of the shampoos, thus their scope is much narrower than what is actually being claimed by applicants and the comparative examples are narrower than the broad disclosures of Schade and Maurin. Regarding applicant's assertion that there wouldn't be an expectation of success in combining Schade and Maurin because the two polymers disclosed are different than applicants, the examiner disagrees, as clearly recited above applicants product by process limitation does not exclude the polymers of Schade. Furthermore as recited in the previous office action one of ordinary skill in the art would have a reasonable expectation of success in substituting the polymers of Schade for the polymers of Maurin since they are both drawn to the same field of endeavor, cosmetic compositions containing cationic vinyl lactams. Thus the substitution of one cationic vinyl lactam for another vinyl lactam would yield predictable results.

Conclusion

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

Art Unit: 1618

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618

Application Number**Application/Control No.**

10/525,232

Examiner

JAMES W. ROGERS

**Applicant(s)/Patent under
Reexamination**

GAUWEILER ET AL.

Art Unit

1618